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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,937	07/11/2000	Jeffry Jovan Philyaw	RPXC - 25,356	2472

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EXAMINER	
KANG, PAUL H	

ART UNIT	PAPER NUMBER
2444	

NOTIFICATION DATE	DELIVERY MODE
02/09/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@dalpat.com

Office Action Summary	Application No.	Applicant(s)	
	09/614,937	PHILYAW, JEFFRY JOVAN	
	Examiner	Art Unit	
	Paul H. Kang	2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 January 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16,18-33 and 35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16 and 18-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 11, 2010 has been entered.

Status of Claims

2. Claims 1-16 and 18-33 and 35 are pending. Claims 17 and 34 have been previously cancelled. Claims 1-16 and 18-33 and 35 stand rejected. A detailed action follows.

Priority

3. This application is a CIP of 09/378,221 (08/19/1999), which is a CIP of 09/151,471 (09/11/1998) and is a CIP of 09/151,530 (09/11/1998) U.S. Patent Number 6,098,106. The effective filing date for the subject matter defined in the pending claims, which has support in parent 09/378,221 in this application, is 08/19/1999. Any new subject mater defined in the claims not previously disclosed in parent 09/378,221, is entitled to the effective filing date of 07/12/2000.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-16, 18-33 and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 11/877,510. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the two pending applications are minor wording, which do not change the scope of the invention. Refer to the below observation for obvious variations of limitation in claims 1-16, 18-33 and 35 of the instant application and claims 1-17 of the pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 7,386,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the two pending applications are minor wording, which do not change the scope of the invention. Refer to the below observation for obvious variations of limitation in claims 1-17 of the instant application and claims 1-34 of the pending application.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-12, 16-18, 19-30, and 33, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al. (U.S. Patent Number 5,978,773), hereinafter referred to as Hudetz, in view of Nelson (U.S. Patent Number 6,297,727) and further in view of Russell et al. (U.S. Patent Number 5,905,248), hereinafter referred to as Russell.

9. Regarding claim 1, Hudetz taught the invention substantially as claimed. Hudetz discloses a method of displaying a web page to a user who has in close association therewith a portable triggering device having a unique code stored therein (Barcodes

having unique codes stored therein; Figures 6 and 7, column 8 lines 17-20) comprising the steps of retrieving location information associated with the unique code from a database, the location information corresponding to a location of the web page on a remote location disposed on the network (Figure 4, column 9 lines 59-62, column 11 lines 33-60); in response to retrieving the location information, connecting the activation system to the remote location (browser software 130 on computer 114 is connected to the remote server; column 11 lines 28-37); and presenting the web page corresponding to the location information of the remote location to the user (Figure 6, column 9 lines 54-62).

However, Hudetz did not expressly disclose a method when the portable triggering device is within a predetermined proximity of an activation system (within range), the activation system interacting with the triggering device causing the unique code from the triggering device to be extracted therefrom through activation thereof by the activation system, the activation system interfaced with a network and physically separates from the triggering device.

Hudetz suggested exploration of art and/or provided a reason to modify the method with the portable triggering device feature (Figure 8, column 6 lines 28-33, column 7 lines 17-28, column 12 lines 11-21).

In an analogous art, Nelson disclosed a method of providing a portable triggering device having a unique code stored therein (Abstract, column 3 lines 10-13, column 5 lines 42-50) and when the portable triggering device is within a predetermined proximity of an activation system (within range), the activation system causing the unique code from the triggering device to be extracted therefrom through activation thereof by the activation system

(transponder identification assembly 10 comprising identification code stored in the memory of transponder 22; column 1 lines 40-47, lines 56-61, column 3 lines 10-13, column 6 lines 8-25), the activation system interfaced with a network and physically separates from the triggering device (column 3 lines 10-13, column 11 lines 9-12).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the known method of Hudetz with the known techniques of Nelson to include the portable triggering device (the transponder) in order to offer users a more automatic method in obtaining the identification code using the interrogator unit and the triggering device (Nelson, column 6 lines 8-21) in order to provide the predictable result to allow users to access published locations without having to manually enter the published address through input devices and increasing remote proximity of the devices (Hudetz, column 2 lines 53-55).

The combination of Hudetz and Nelson taught the invention substantially as claimed. However, the combination of Hudetz and Nelson did not teach in response to retrieving the location information, *automatically* connecting the activation system to the remote location.

Hudetz suggested exploration of art and/or provided a reason to modify the method with the automatic connection with the remote location (column 2 lines 52-67).

Russell disclosed a method wherein in response to retrieving the location information, *automatically* connecting the activation system to the remote location (Title, Abstract, column 2 lines 46-67, column 3 lines 1-26).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combined method of Hudetz and Nelson with the known

technique of Russell to include the automatic connection feature for the predictable result of allowing users to access published locations automatically without manual inputs (Hudetz, column 2 lines 52-67).

10. Regarding claim 2, Nelson disclosed a method wherein the triggering device in the step of providing is a portable wireless passive transponder (Figure 1 a sign 22, Figure 3 sign 34, column 1 lines 40-47, column 5 lines 42-47, column 7 lines 1-5).

11. Regarding claim 3, Nelson disclosed a method wherein the passive transponder has the unique code stored therein in a non-volatile memory (Abstract, column 3 lines 10-13, column 5 lines 42-47, column 1 lines 56-61, column 12 lines 4-13).

12. Regarding claim 4, Hudetz disclosed a method wherein the unique code in the step of providing is uniquely associated with the web page (Figure 4, column 9 lines 54-62).

13. Regarding claim 5, Nelson disclosed a method wherein the triggering device further includes a unique transponder identification code stored therein, the unique transponder identification code being exclusively associated with that triggering device (column 5 lines 59-66, column 6 lines 9-25).

14. Regarding claim 6, Nelson disclosed a method wherein the step of causing further includes causing the unique transponder identification code to be extracted from the triggering

device with the activation system (column 6 lines 9-25, column 5 lines 59-66, lines 39-54).

15. Regarding claim 7, Nelson disclosed a method wherein the step of retrieving location information further comprises the step of matching the unique code and the unique transponder identification code with the location information of the database (column 3 lines 1-5, column 5 lines 59-66, column 11 lines 48-55).

16. Regarding claim 8, Nelson disclosed a method wherein the activation system in the step of extracting comprises a transmitter and a receiver each operatively connected to a interrogator unit [computer], the transmitter for activating the triggering device with an activating signal, and the receiver for receiving a triggering signal having the unique code contained therein (Figure 3, column 6 lines 13-23, lines 39-54).

17. Regarding claim 9, Nelson disclosed a method wherein the step of retrieving location information further comprises the step of matching the unique code with the location information of the database (column 9 lines 42-45, column 10 lines 29-36, lines 3-10).

18. Regarding claim 10, Hudetz disclosed a method wherein the database in the step of retrieving is local to the activation system (column 7 lines 51-57).

19. Regarding claim 11, Hudetz disclosed a method wherein the database in the step of retrieving is located at an intermediary location on the network (Figure 1 sign 60,

Figure 4, column 7 lines 43-51).

20. Regarding claim 12, Hudetz disclosed a method wherein the step of retrieving location information from the intermediary location further comprises the step of appending to the unique code routing information which defines the location of the intermediary location on the network such that the unique code is transmitted to the intermediary location in accordance with the appended routing information (column 11 lines 28-37).

21. Regarding claim 16, Hudetz disclosed a method wherein the step of connecting is performed using a browser program (Figure 6, column 1 lines 46-52, column 10 lines 55-67).

22. Regarding claim 18, Hudetz disclosed a method wherein the step of presenting comprises displaying the web page to the user via display operatively connected to the activation system (Figure 6, column 9 lines 54-62).

23. Regarding claims 19-30, 33, and 35, the apparatus corresponds directly to the method of claims 1-12 and 16-18, and thus these claims are rejected using the same rationale.

24. Claims 13-15 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hudetz, Nelson, and Russell as applied above, and further in view Wellner (U.S. Patent Number 5,640,193).

25. Regarding claim 13, Hudetz disclosed a method of displaying a web page to a user (Figure 6, column 8 lines 17-20) comprising the steps of retrieving location information associated with the unique code from a database, the location information corresponding to a location of the web page on a remote location disposed on the network (Figure 4, column 9 lines 59-62, column 11 lines 33-60); in response to retrieving the location information, connecting the activation system to the remote location (column 11 lines 28-37); and presenting the web page corresponding to the location information of the remote location to the user via the activation system (Figure 6, column 9 lines 54-62). Nelson disclosed a method of providing a portable triggering device having a unique code stored therein (Abstract, column 3 lines 10-13, column 5 lines 42-50) and extracting the unique code from the triggering device with an activation system when the portable triggering device is proximate to the activation system (column1 lines 40-47, lines 56-61, column 3 lines 10-13, column 6 lines 8-25), the activation system disposed on a network and physically separates from the triggering device (column 3 lines 10-13, column 11 lines 9-12). Russell disclosed a method wherein in response to retrieving the location information, *automatically* connecting the activation system to the remote location (Title, Abstract, column 2 lines 46-67, column 3 lines 1-26).

The combination of Hudetz, Nelson, and Russell did not disclose a method wherein the activation system in the step of causing further includes a unique interface identification code associated with the activation system. However, in an analogous art, Wellner disclosed a method wherein the activation system in the step of extracting further includes a unique interface identification code associated with the activation system (Abstract, column 1 lines 36-

42, column 7 lines 3-10).

It would have been obvious to one of ordinary skill in the art at the time of the in was made to modify the combined teachings of Hudetz and Nelson with the teachings of Wellner to include a unique interface identification code in order to allow a user to control the selection of electronic services to be provided to the user by one or more servers over a communication medium (Wellner, column 1 lines 33-36) because this enables the selected electronic service transmitted from the servers to be received by the user's receiver (Wellner, column 1 lines 42-44).

26. Regarding claim 14, Wellner disclosed a method wherein the step of retrieving location information further comprises the step of appending the unique interface identification code to the unique code and transmitting it to the database (column 1 lines 36-42, column 5 lines 46-55).

27. Regarding claim 15, Wellner disclosed a method wherein the step of retrieving location information further comprises the step of matching the unique code and the unique interface identification code with the location information of the database (column 1 lines 36-42, column 4 lines 46-52). Hudetz also disclosed this matching step at column 8 lines 47-53).

28. Regarding claims 31-32, the apparatus corresponds directly to the method of claims 13-15, and thus these claims are rejected using the same rationale.

29. Claims 1-4, 8, 9, 10-11, 16, 18-22, 24, 26, 28-29, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al. (U.S. Patent Number 6,446,871), hereinafter referred to as Buckley in view of Schmitt et (U.S. Patent Number 5,903,225), hereinafter referred to as Schmitt.

36. Regarding claims 1 and 19, Buckley disclosed a method and an apparatus for displaying a web page to a user who has in close association therewith a portable triggering device having a unique code stored therein (Figure 9) comprising: a portable device of a user having a unique code stored therein (Figure 1, column 4 lines 49-61, column 5 lines 49-61); and an activation system disposed on a network for extracting the unique code from said device through activation thereof by the activation system, said activation system physically separate from said device (column 4 lines 49-61, column 5 lines 49-61, column 8 lines 60-column 9 line 7, column 10 lines 32-39); wherein location information associated with said unique code is retrieved from a database, said location information correspond to a location of the web page on a remote location disposed on said network (column 4 lines 62-column 5 lines 8, column 8 lines 60-column 9 line 7); wherein in response to said location information being retrieved from said database, said activation system is automatically connected to said remote location (column 3 lines 31-41, column 8 lines 60-column 9 line 7); wherein the corresponding web page of said remote location is presented to the user via said activation system (Figure 9, column 8 lines 60-column 9 line 7, column 12 lines 5-14).

Berkley taught the invention substantially as claimed; however, Berkley did not expressly disclose a portable *triggering* device having a unique code stored therein and

causing extraction of the unique code from the triggering device with an activation system operable to interface with the portable triggering device *when the portable triggering device is proximate to the activation system.*

Berkley suggested exploration of art and/or provided a reason to modify the method and apparatus with other features such as wireless and portable triggering device (column 4 lines 56-61, column 5 lines 49-55, column 11 lines 27-37, column 12 lines 52-58).

In an analogous art, Schmitt disclosed a portable triggering device [passive transponder] of a user having a unique code stored therein (Abstract, Figure 14, column 2 lines 51-60), which is activated when the portable triggering device is within a predetermined proximity (within range) to the activation system (Schmitt, column 3 lines 7-18, lines 53-57, column 12 lines 47-59, column 13 lines 3-15, column 14 lines 26-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and apparatus of Berkley with the teachings of Schmitt to include a portable triggering device of a user having a unique code stored therein in order to eliminate the cumbersome scanner because the triggering device would communicate with the activation system automatically when the user is in contact with the activation system (Schmitt, column 12 lines 4-55). In addition, the portable triggering device would prevent the users through the inconvenience of locating and manipulating the reader or scanner system (Schmitt, column 2 line 61-column 3 line 3).

30. Regarding claims 2 and 20, Schmitt disclosed a method and an apparatus wherein the triggering device is a portable wireless passive transponder (Abstract, column 3 lines 7-11,

lines 53-57).

31. Regarding claims 3 and 21, Schmitt disclosed a method and an apparatus wherein said passive transponder has said unique code stored therein in a non-volatile memory (column 3 lines 14-17, lines 22-26, column 12 lines 11-14, lines 25-33).

32. Regarding claims 4 and 22, Buckley disclosed a method and an apparatus wherein said unique code is uniquely associated with the webpage (column 8 lines 60-column 9 lines 7).

33. Regarding claims 8 and 24, Schmitt disclosed a method and an apparatus wherein said activation system comprises a transmitter and a receiver each operatively connected to a computer, said transmitter for activating said triggering device with an activating signal, and said receiver for receiving a triggering signal having said unique code contained therein (Figure 14, column 2 lines 51-60, column 3 lines 7-14).

34. Regarding claims 9 and 26, Buckley disclosed a method and an apparatus wherein said unique code is matched with said location information of said database (column 2 lines 45-52, column 5 lines 3-15, column 7 lines 39-49).

35. Regarding claims 10 and 28, Buckley disclosed a method and an apparatus wherein said database is local to said activation system (Figure 7 sign 90, column 4 line 62-column 5

line 8).

36. Regarding claims 11 and 29, Buckley disclosed an apparatus wherein said database is located at an intermediary location on said network (column 4 line 62-column 5 line 8, column 8 lines 60-column 9 lines 7).

37. Regarding claims 16 and 33, Buckley disclosed a method and an apparatus wherein said activation is connected to said remote location using a browser program (Figures 4, 5, 9, column 11 lines 18-27, column 12 lines 5-14).

38. Regarding claims 18 and 35, Buckley disclosed a method and an apparatus wherein the webpage is presented to the user via a video display operatively connected to said activation system (Figures 4, 5, 9, column 11 lines 18-27).

Response to Arguments

39. Applicant's arguments filed January 11, 2010 have been fully considered but they are not persuasive. The applicants argued in substance that:

> a. "Applicant submits that the proposed primary combination of Hudetz and Nelson is flawed. For example, Hudetz describes various scenarios in which a barcode may be scanned from "ordinary articles of commerce" (see, e.g., Abstract). However, if combined with the RFID system of Nelson, there is no teaching or suggestion as to how a particular barcode would be scanned if multiple barcodes are in range. In other words, if each article of commerce contains a barcode as proposed by Hudetz, how will the RFID system of Nelson recognize which particular code is desired by a user for scanning."? How would a user choose a particular barcode? In Hudetz, such differentiation between various barcodes that are in close proximity is not required other than by scanning of the proper barcode by the user.
>
> "Applicant submits that one skilled in the art would not be motivated to combine the two systems of Hudetz and Nelson, each of which performs a specific function in order to fulfil a specific purpose, because such a combination would not result in an advantage to either system.

> Hudetz has no need for "expanding the required proximity of the device" as stated in paragraph 37 of the Office Action because a user is personally selecting a particular barcode and has no need for expanded proximity. Nelson's RFID has no need of Hudetz's passive tag as that defeat the purpose of the invention of Nelson. Accordingly, Applicant submits that one skilled in the art would not be motivated to combine the Buckley and Schmitt references as described in the Office Action" See Remarks, page 7, line 13 – page 8, line 3.

As to point a), the examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the artisan of ordinary skill would have found obvious to apply the known techniques of Nelson including the portable triggering device (transponder assembly 10) to the system of Hudetz for the predictable result of allowing users to access published locations without having to manually enter the published address through input devices and increasing remote proximity of the devices (Hudetz, column 2 lines 53-55). This would offer users an automatic method in obtaining the identification code using the interrogator unit and the triggering device (Nelson, column 6 lines 8-21). Furthermore, Hudetz, Nelson and Russell teach techniques known to the artisan of ordinary skill at the time of the invention. The various techniques of using coded information readable by a device, such as a bar code or RFIDs, were within the ordinary capabilities of one skilled in the art. Both techniques aim to obtain information regarding a specific target by a mechanized system. The general barcode system of Hudetz is limited by the required proximity of the triggering device with the activation system and by the need for user activation of the activation system.

Nelson's RFID remedies this deficiency by using RF signals to remotely transmit coded information expanding the required proximity of the devices. The predictable result of expanding the proximity of the devices and automating the activating step would have been obvious to the artisan of ordinary skill as these techniques were within the ordinary capabilities of one skilled in the art. Therefore, applicant's assertion that the prior art references teach a specific function in order to fulfill a specific purpose and therefore such a combination would not result in an advantage to either system is not persuasive.

> b. "In other words, as recognized in the Office Action, the passive tag of Hudetz does not and cannot interact or be activated as required by Claims 1 and 19. Therefore, the RFID of Nelson is substituted in the Office Action for the passive tag of Hudetz. The Office Action further states in paragraph 37 that "the general barcode system of Hudetz is limited by the required proximity of the triggering device with the activation system and by the need for user activation of the system. Nelson's RFID remedies this deficiency by using RF signals to remotely transmit coded information expanding the required proximity of the device." However, nowhere does Hudetz indicate that it would be desirable to expand the "required proximity" of the passive device. In fact, Hudetz discloses in column 12, lines 11-21, an RF data collection scanner (i.e., an extender device that scans a barcode using traditional scanning methods and then transmits the scanned information via an RF signal rather than a cable) that replaces a cable connecting the scanner to the remainder of the system but provides no teaching or suggestion for increasing the proximity of the passive device itself. In fact, as stated previously, Applicant submits that such an expanded proximity may actually complicate the operation desired in Hudetz without providing any advantages, as a user may have to somehow distinguish between multiple barcodes rather than simply scan the desired barcode without gaining any benefit from the expanded proximity. Accordingly, Applicant submits that it would not be obvious for one skilled in the art to integrate the RFID of Nelson with the passive device of Hudetz. The remaining references do not remedy these deficiencies of the Hudetz and Nelson combination." See Remarks, page 10, lines 1-19.

In response to applicant's argument that the "passive tag" of Hudetz is incompatible with the RFID of Nelson, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the artisan would

have applied the known transponder identification technology of Nelson to the barcode reading system of Hudetz to achieve the stated predictable result. Therefore, applicant's argument that a barcode is incompatible with a RFID is not deemed persuasive.

Applicant submits substantially the same arguments regarding the rejection under 103(a) over Buckley in view of Schmitt are treated above. See Remarks, page 11, lines 5-23 and page 13, line 26 – page 14, line 10. As the applicant has presented substantially the same arguments here as regarding the rejection under 103(a) in view of Hudetz, Nelson and Russell, the examiner relies on the same rationale stated above.

Applicant is invited to request an interview with the examiner prior to filing a response to an Office action.

Conclusion

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H Kang/
Primary Examiner
Art Unit 2444